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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,798	11/13/2006	Karl-Heinz Wenzelburger	11601-33	4909
20311 7590 11/09/2010 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER HOWELL, DANIEL W				
ART UNIT		PAPER NUMBER		
3726				
NOTIFICATION DATE		DELIVERY MODE		
11/09/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

Office Action Summary

Application No.

10/583,798

Applicant(s)

WENZELBURGER, KARL-HEINZ

Examiner

Daniel W. Howell

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-27 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-27, 30-31, 34 is/are rejected.
- 7) ☒ Claim(s) 32 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The last full paragraph on page 3 of the specification states that the adjustment means may be arranged eccentrically to the axis of the boring head, but the specification give no guidance what that means, or how such an embodiment would appear.
2. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear in what manner the adjustment means is “arranged eccentrically” to the axis of the boring head means, or what the scope of this limitation is.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the eccentric adjustment means of claim 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17-20, 22-27, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzsimmons (3625624) in view of Perkins (2400839). Fitzsimmons shows cassettes 18' which are radially slidable in grooves 30' of housing 12'. A single adjustment piece 44 is placed at the axis of rotation, and the cartridges are placed against this piece 44 before screws 28' are tightened, such that both of the cartridges are placed at the desired radial location simultaneously. The piece 44 has a hole through which locking screw 52 extends along the axis of rotation. Each of the cartridges has a cutting insert 24'. As such Fitzsimmons lacks a guide element. Perkins shows a similar boring bar having cutter cartridge c1 and two guides i1, e1. Note that all of the cartridges are radially adjustable to desired locations. In view of Perkins teaching of providing guides i1, e1, it is considered to have been obvious to have embodied one of the cartridges of Fitzsimmons as a guide element in order to properly center the cutter along the axis of rotation, such that a hole of desired tolerances is made. Regarding claims 23-28, it is

noted that the piece 44 is rectangular in cross section, with a central hole for screw 52. It is considered to have been obvious to have provided this piece 44 with other shapes, such as cylindrical or disk-shaped, as the piece 44 would still work the same regardless of the shape of its outer circumference.

6. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzsimmons '624 in view of Perkins '839 as applied to claim 17 above, and further in view of McClay (1797582). McClay shows a similar cutter having alternating cutting blades 17 and guides 16. The cutters are moved radially by an axially movable conical section 15, and the guides are moved radially by an axially movable conical section 13. It is considered to have been obvious to have provided Fitzsimmons with an axially movable conical piece as shown at 15 of McClay in order to simultaneously move the cartridges radially outward an equal amount. McClay also shows a cover 18 on the front of body 10. It is considered to have been obvious to have provided Fitzsimmons with a cover as shown by McClay in order to prevent debris from getting into the guide grooves for the cartridges.

7. Claims 32 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Applicant's arguments filed 8-25-10 have been fully considered but they are not persuasive. Regarding claim 21, Applicant has responded, "a person skilled in the art (i.e., an engineer) *knows how an adjustment means which is arranged eccentrically to the axis of the boring head works* and how it is arranged in the boring head." Oh? *Knows* how it works? With all due respect, for one skilled in the art to "*know*" how it works, there is an implication that the

feature is actually known in the art. Is this feature already present and known in the prior art? If yes, then Applicant is reminded of their duty to disclose prior art known to them. Claim 17 sets forth "a single adjustment means," and dependent claim 21 states that the adjustment means is eccentric. JP 60-56813 shows a series of eccentric locators 11, but there are more than one (not single). It does not appear that such a single eccentric locator is known in the prior art. It is not clear from the specification how eccentric adjustment means of page 3 and claim 21 would appear, and the specification gives no particular guidance. The enablement rejection has been repeated. Regarding the art rejection, Applicant has stated that Perkins does not show simultaneous of the insert and guide element. That's not quite what Perkins was applied for. Fitzsimmons was applied to show the concept of two simultaneously adjustable cartridges. Perkins was applied to show that one cartridge may have a cutting insert and the opposite cartridge may have a guide element, and therefore that one of the cartridges of Fitzsimmons could be provided with a guide element. Between these two references, all of the limitations of claim 17 have been taught.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, David Bryant, may be reached at 571-272-4526.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3726 at the top of your cover sheet.

/Daniel W. Howell/

Primary Examiner, Art Unit 3726